

In the decision of March 19, 2003, by the Board of Patent Appeals and Interferences, patentable subject matter was found to be distinguishable from Connell and Taylor for reasons set forth on page 8 of that Decision. Specifically, the Board found that there was nothing disclosed in Connell or Taylor that suggested providing a label with plural subsections respectively comprising an icon and a set of descriptive information relating to a performance characteristic of the ball as required by independent claims 12 and 31 and that none of the package article characteristics depicted by the Connell label can reasonably be interpreted as performance characteristic. (See page 8 of Board's decision.)

The Examiner now applies the secondary references of Sullivan, Matney and Boggs to allegedly teach these performance characteristics. Applicant disagrees with the Examiner's reasoning as follows.

Sullivan is directed to an in-mold label having removable coupon portion. The Examiner refers to col. 4, lines 9-15 for providing the performance characteristics. However, Sullivan merely teaches providing indicia for a motor oil container with the permanent portion bearing company name and oil specification information while the removable portion bears a proof-of-purchase bar code for redemption. Sullivan teaches specification information of the oil, but not information pertaining to performance characteristics of the oil. Therefore, Applicant submits that Sullivan is not applicable to the invention.

Matney is relied upon by the Examiner because it teaches a nail polish bottle having a label indicia disclosing properties such as flammability in Fig. 2. However, flammability is not a

performance characteristic of the nail polish. Rather, it is a label for safety features, having nothing to do with the use of nail polish in its intended environment.

Lastly, the Examiner relies on Boggs for teaching a multi-use label having indicia that discloses high and low energy cost associated with a particular product with reference to col. 3, lines 54-64 and Fig. 1. Applicant submits that this information is not performance characteristics. Instead, relative to a water heater, performance characteristics would be, for example, the ability to heat water to a certain temperature such as 100°, or to heat the water temperature to 100° within so many minutes. In addition, the capacity of the water tank would also seem to be a performance characteristic and how much water flow is possible during the period of operation. Therefore, Applicant submits that Boggs is also not applicable to the invention.

Accordingly, for the foregoing reasons, Applicant submits that the new combination set forth by the Examiner is insufficient to render independent claims 12 and 31 unpatentable. Applicant also submits that dependent claims 13-30 and 32-43 are patentable at least by virtue of their dependency.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.


Response Under 37 C.F.R. § 1.111  
U.S. Serial No. 08/988,181

Attorney Docket No.: Q48708

Pursuant to 37 C.F.R. § 1.136, Applicant is submitting a petition (with fee) for an extension of time of three months, extending the time for responding to this Office Action to July 13, 2004. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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